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REMARKS:

The comments of the Examiner as set forth in the Office Paper mailed 5 October, 2005 have been carefully studied and reviewed.

5 Claims 1-33 are pending in the application.

Claims 1-15, and 27-33 have been withdrawn from consideration.

Claims 16-26 have been rejected.

10 **Election/Restriction**

Applicants hereby affirm the provisional election to prosecute the claims of group II (Claims 9-26, drawn to a method for manufacturing a skateboard deck), Species B (Claims 16-26), drawn to the graphite cloth layers already having the resin therein as disclosed on p. 11, line 13 - p. 13, line 34.

20 **Information Disclosure Statement**

An Information Disclosure Statement by Applicants is submitted herewith as a separate paper.

25 **Claim Rejections: 35 U.S.C. §103**

Claims 16-23, and 25-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Renard (US 2002/0064640) in view of Valleau et al. (U.S. Pat. No. 5,028,100).

0 The basis of this rejection is that while Renard teaches making a skateboard deck, it is silent as to the cloth being graphite cloth, and it is known in the art to make a skateboard deck from resin-impregnated cloth layers, as alleged to be taught by Valleau et al.

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Therefore, it would have been obvious to the skilled artisan to use graphite fibers for the cloth layers of Renard because such is known in the skateboard deck art, as taught by Valleau et al., where such a material offers superior strength, stiffness, dimensional stability toughness, low weight and low cost--especially in light of the fact that Renard teaches the fibers can be carbon and/or metal fibers and graphite is derived from carbon and exhibits metallic properties.

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Applicant respectfully traverses these rejections. To reject a claimed invention based upon its obviousness over the prior art, the examiner must support such a rejection by establishing the invention's prima facie obviousness. The examiner must show where in the art cited there is a description of the claimed invention sufficient to have taught or suggested the invention to ordinarily skilled artisans of the time (see, e.g., ACS Hospital Systems, Inc., v. Montefiore Hospital, 221 USPQ 929, 933 (F. Cir. 1984); see also, In re Fine, 5 USPQ2d 1596 (F. Cir. 1988)).

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Evaluation of whether the cited documents provide the necessary description requires consideration of "(1) whether the prior art would have suggested to those of ordinary

Patent

U.S. Ser. No. 10/725,262 Canizales et al.

Page 7 of 12

0 skill in the art they should make the claimed [invention] ... and (2) whether the prior art would have also revealed that in so making ... those of ordinary skill would have a reasonable expectation of success" (In re Vaeck, 20 USPQ2d 1438, 1442 (F.Cir. 1991)). "Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure" (In re Vaeck, supra). That is, "one cannot use hindsight reconstruction to pick and choose amongst isolated disclosures in the prior art to deprecate the claimed invention" (In re Fine, supra at 1600).

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15 But there is no teaching in either reference to manufacture a skateboard deck from graphite cloth that has its maximum deflection between the regions of the skateboard deck where the trucks will be attached to the deck. The claimed process of making a skateboard deck produces a skateboard that has properties (see paragraph below) that are not described in the cited references.

20 Claims 16 has been amended to describe the claimed invention in greater detail. As Applicants have described in the specification, the number of layers to be used in the skateboard deck is determined based on a combination of the weight of the rider, and the conditions under which the skateboard deck will later be used, not merely some randomly chosen mathematical function. Applicants' process produces a skateboard deck that is not like skateboard decks prepared using processes of the prior art; the skateboard deck produced using the claimed process has its' maximum

0 deflection at a point that is halfway between where the skateboard trucks will be attached. Thus, when the skateboard is used, the deflection of the deck consequently produces a greater downward force when the skateboard is used for cornering, enabling the rider of the skateboard to have greater control over the skateboard than could be achieved with skateboard decks manufactured using prior art processes.

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10 Thus, with no such teaching in the prior art, nor in the references cited by the Examiner, there can be no prima facie case of obviousness, and the rejection of Claim 16 under 35 U.S.C. §103(a) must, respectfully, be withdrawn.

15 The basis for this amendment is Claims 25 and 26 as originally filed, and the specification from page 15, line 1 through p. 17, line 3, and particularly at p. 15, lines 1-33, and p. 16, line 28 - p. 17, line 3. Claims 25 and 26 have been cancelled to avoid duplication of claims.

20 **Claims 17-23**

25 Claims 17-23 were rejected under 35 U.S.C. §103(a) because it is alleged that the selection of process parameters such as heating temperature, etc. would have been within the purview of the skilled artisan.

Applicants respectfully traverse this rejection, because having distinguished the independent claim, Claim 16 over the prior art, Applicants respectfully submit that these dependent Claims similarly define patentable subject

0 matter, and accordingly, the rejection of Claims 17-23 under
35 U.S.C. §103(a) must therefore be withdrawn.

Claims 25 and 26

5 Claims 25 and 26 have also been rejected under 35
U.S.C. §103(a).

10 Claims 25 and 26 have been cancelled to avoid being
duplicate claims and to facilitate the prosecution of this
application. The language of original Claims 25 and 26 has
been included in amended Claim 16, as described previously.

Claim 24

15 Claim 24 was rejected under 35 U.S.C. §103(a) as being
unpatentable over Renard et al. and Valleau et al. as
applied to claim 17 above, and further in view of Moore
(U.S. Pat. No. 4,295,656).

20 The Examiner alleges that Renard is silent as to an
additional layer comprising fiberglass and the resin being
used for the deck bottom, but that it is known in the
skateboard deck art to mold a plurality of layers to form a
skateboard deck "core" and then apply resin-impregnated
fiberglass layers to the top and bottom of the "core" to
achieve tapered wing sections that retain lateral
25 flexibility for turn radius control, as taught by Moore
(abstract; col. 4, lines 10-12, 16-18, 27-31 and 44-55).

Applicant respectfully traverses this rejections.

Claim 24 does not discuss wing sections that retain lateral

0 flexibility for turn radius control; this is a property
mentioned in the Moore reference. The Moore reference
emphasizes that the degree of flexibility is dependent upon
a combination of the thickness of the planks in the deck
core, and the number of layers of the fiberglass cloth in
5 combination with impregnation of a particular resin which
may be more or less flexible when cured (col. 4, lines 32-
37). As shown in the cross-sectional views of Moore's Figs.
4 and 7, the wings extend over a deck and obviously contain
several layers of fiberglass. In view of Moore's teaching
10 that it is the combination of the layers of material that
provide the flexibility to the deck and the wings, there is
no suggestion in the reference to use only a single layer of
material beneath the deck. There is no teaching in the
reference to suggest that use of a single layer of material
15 would provide the properties sought, this is based on
impermissible speculation by the Examiner. Therefore, the
rejection of Claim 24 under 35 U.S.C. §103(a) must
respectfully, be reversed.

20 **Conclusion**

Thus, the present pending Claims distinguish over the
prior art and define patentable subject matter.

25 Applicant thanks the Examiner for her thoughtful review
of this application, and respectfully requests the Examiner
review the pending Claims and to find that they define
patentable subject matter. Thus, it is respectfully
requested that the present pending Claims be allowed.

Patent
U.S. Ser. No. 10/725,262 Canizales et al.

Page 11 of 12

0 In the event that this Amendment does not place the application in condition for allowance, the Examiner is respectfully requested to telephone the undersigned in order that an attempt can be made to place the application in condition for allowance as expeditiously as possible.

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Respectfully submitted,



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Patent
U.S. Ser. No. 10/725,262 Canizales et al.

Page 12 of 12